


Appl. No. 09/895,027
Atty. Docket No. 8610
Response dated November 14, 2003
Reply to Office Action of November 3, 2003
Customer No. 27752

REMARKS

Claims 1-9 and 14 are pending in the application and stand rejected. Claims 1-9 and 13 have been rejected under 35 U.S.C. § 103. No fee is due.

Rejection Under 35 USC 103(a) Over Roberts et al. (U.S. 6,101,486) in view of Brockman et al. (U.S. 5,826,240)


Claims 1-9 and 14 have been rejected under 35 USC 103(a) as being unpatentable over Roberts et al. (U.S. Patent 6,101,486) in view of Brockman et al. (U.S. Patent 5,826,240). However, the Office Action does not make out a proper *prima facie* of obviousness with respect to Claim 1, and this rejection should, therefore, be withdrawn.

Firstly, the office action purports to make out a *prima facie* case of obviousness based on the combination of Roberts et al. and Brockman et al. In order for such a combination of references to be proper, however, there must be some teaching or suggestion of the desirability of the combination in the first instance. The Office Action contains no analysis showing any motivation for making this combination, but simply concludes on page 4, "It would be obvious to one skilled in the art to modify the method of Roberts so that the product information includes consumer sales projection information, as taught by Brockman, to help increase customer sales efficiency." This conclusory reason is deficient for two reasons 1) it is not sufficient to show the prior art (and not the applicants disclosure) recognized the desirability of making this modification, and 2) in any event, it mischaracterizes both the claimed invention and the teachings of Brockman et al. and Roberts et al. 

Even if the Office Action had met its threshold burden of showing the motivation to combine the references in the manner suggested in the Office Action, the rejection of Claim 1 would still be defective. A additional requirement of a *prima facie* case of obviousness is that the combination of references must teach all features of the claimed invention. A close reading of the Brockman et al. and Roberts et al. patents reveals that this requirement is not met by the Office Action.

The Office Action points to column 4, lines 47+ for supposedly disclosing a method for facilitating the sale of products and services to consumers that includes providing product information to customers with consumer sales projection information. However, this reading of the Brockman et al. patent is not correct. Brockman et al. deals with an interface for car dealerships to access databases of past customers, repeat customers, and "hot prospects." This

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allows car salespersons to know some more background about potential car buyers on the lot. This is not the same as providing sales projection information as required by Claim 1. There is nothing in Brockman et al. which deals with the calculation of the projection of the customer's (i.e. the user of the system) sales based upon expected purchases from the consumers. At best  Brockman et al. merely discloses to a user of the system who has purchased a car before, and who has been on the lot before – this does not quantify projected sales information of the user of the system (i.e. the customer) in the manner claimed in Claim 1.

Simply grafting these few lines from the Brockman et al. patent into the disclosure of the Roberts et al. patent does not result in the method of Claim 1 in its entirety. The Office Action provides no motivation for making the combination in the first instance, no showing of a reasonable expectation of success, no showing that the nature of the problem to be solved was appreciated, and no showing that each element of Claim 1 would thereby result.

Even the characterization of the Roberts et al. patent of accessing customer information for a pre-existing database (cited at Fig. 3, element 340) is incorrect. As previously noted in response to prior office actions, the term customer as used in the Roberts et al. patent is not the same as the term customer in claim 1. The cited portion of Roberts et al. discloses nothing about customer sales information, it relates to consumer sales information. In the Amendment transmitted on September 11, 2203, this was made clear by expressly defining in Claim 1 that a customer is a purchaser of goods for subsequent re-sale to consumers. This feature is not present in Roberts et al, and the cited sections of Brockman et al. do not make up for this deficiency. The Office Action glosses over this distinction between the claimed invention and the prior art by one sentence on Page 3 stating: "Furthermore, it would be obvious to one skilled in the art that the customer purchasing the goods could play a variety of roles (consumer of goods, reseller of good, transporter of goods, etc.)." This summary conclusion, however, is without support in the analysis in the Office Action or any teaching cited to in the record.

For all of the above reasons, the Office Action has not made out a proper *prima facie* case of obviousness with respect to Claim 1 and the rejection of Claim 1 should be withdrawn. Claims 2-9 and 14 all depend from claim 1 and are patentable over the cited references for at least the reasons given above with respect to Claim 1. Therefore, the rejections under 35 U.S.C. § 103 for all of Claims 1-9 and 14 should be withdrawn.

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Conclusion

All of the relevant rejections and objections in the Office Action have been addressed.

No new matter has been added by this response.

In light of the discussions contained herein, Applicants respectfully request reconsideration of the rejections and their withdrawal and that all of the claims be allowed.

Issuance of a notice of allowance at an early date is respectfully requested.

Respectfully submitted,

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